

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

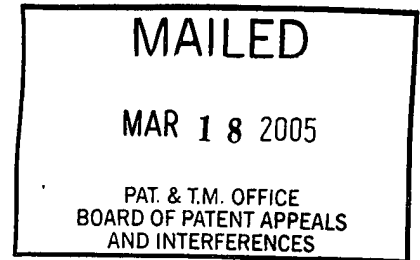
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SUZANNE F. GROEMMINGER

Appeal No. 2005-0112
Application No. 09/737,004

ON BRIEF



Before KIMLIN, PAK, and TIMM, *Administrative Patent Judges*.
TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1-12. Claims 13-20, the only other claims pending in the application, have been withdrawn by the Examiner. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

INTRODUCTION

The Examiner maintains rejections under 35 U.S.C. § 103(a). As evidence of unpatentability, the Examiner relies upon the following prior art references:

Heiler et al. (Heiler) (Pub. Int'l. Application)	WO 97/43,373	Nov. 20, 1997
Hu et al. (Hu) (Pub. Int'l. Application)	WO 00/37,049	Jun. 29, 2000

Claims 1-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hu.
Claims 1-4 and 6-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Heiler.

Appellant groups the claims separately, but Appellant does not provide separate arguments for each group in accordance with 37 CFR § 1.192(c)(7) and (8), the rule in force at the time the Brief was filed.¹ We, therefore, select a single claim to decide the issues for each rejection. We select claim 1. Claim 1 reads as follows:

1. An aqueous composition for cleaning and wetting a contact lens comprising:
 - (a) a non-amine polyethyleneoxy-containing material having an HLB value of at least about 18;
 - (b) a first non-ionic surface active agent having cleaning activity for contact lens deposits that comprises a poloxamine;
 - (c) a second non-ionic surface active agent having cleaning activity for contact lens deposits and that comprises a non-poloxamine surface active agent with an HLB value less than that of said non-amine polyethyleneoxy-containing material; and

¹Note that effective September 13, 2004, 37 CFR § 1.192 has been replaced by 37 CFR § 41.37(c)(69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sept. 7, 2004)).

(d) a wetting agent.

We affirm substantially for the reasons set forth by the Examiner and add the following primarily for emphasis.

OPINION

According to Appellant, no *prima facie* case of obviousness has been established because Hu does not teach the present invention or the surprising beneficial effects thereof, namely, improved removal of deposits on contact lenses (Brief, p. 7). This is because, according to Appellant, Hu does not teach dual cleaning agents for improved *removal* of lens deposits, in addition to comfort agents and wetting agents, as is claimed in the present invention. (*Id.*). Appellant argues that compositions effective in *preventing* deposits on contact lenses (Hu) are not necessarily effective in *removing* deposits from contact lenses and, therefore, one would not have been obvious in view of the other (*Id.*).

Appellant's argument is not convincing because it neglects the nature of both the claims and the prior art. The claims are directed to a composition. Consequently, as properly interpreted, claim 1 is directed to a composition that contains the specified ingredients at any time from the moment at which the ingredients are mixed together. *See Exxon Chem. Pats., Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1557, 35 USPQ2d 1801, 1804 (Fed. Cir. 1995), *cert. denied*, 518 U.S. 1020 (1996). That the prior art has a different reason or motivation to combine the ingredients is of no moment as long as there is a reason, suggestion, or motivation to make the

combination. *See In re Kemps*, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1311 (Fed. Cir, 1996)(“[T]he motivation in the prior art to combine the references does not have to be identical to that of the applicant to establish obviousness.”); *In re Beattie*, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992).

We agree with the Examiner that Hu suggests formulating a cleaning composition having the four components required by claim 1. Particularly, Hu suggests a composition including an ethoxylated glucose derivative such as Glucam® E-20, which, according to Appellant’s specification, is a non-amine polyethyleneoxy-containing material having an HLB value of at least about 18 in accordance with component (a) of claim 1 (Hu, p. 6, ll. 23-28, specification, p. 3, ll. 10-12 and claim 5). Hu further suggests including poloxamine surfactants meeting the requirements of component (b) of claim 1 in the composition (Hu, p. 6, ll. 3-15). Hu also discloses that the composition can optionally include additional compatible surfactants known to be useful in wetting or rewetting solutions such as polysorbate 20 (Hu, p. 7, ll. 9-10). Polysorbate 20, according to Appellants’ specification, is a non-ionic surface active agent meeting the requirements of component (c) of claim 1 (specification, p. 4, ll. 10-22). See also claim 7 which limits component (c) to polysorbate 20. Hu further suggests adding cellulosic polymers and derivatives thereof which meet the requirements of the wetting agent of component (d) of claim 1 (compare Hu, p. 7, ll. 25-31 with specification, p. 5, ll. 6-8 and claim 9). While Hu is motivated to make the cleaning composition for a somewhat different purpose than

Appellant, there is a reason, suggestion or motivation for preparing the composition as is required to establish a *prima facie* case of obviousness.

We also agree with the Examiner that the words in the preamble of the claim “for cleaning and wetting a contact lens” are merely a statement of intended use (Answer, pp. 3-4). “A mere statement of a new use for an otherwise old or obvious composition cannot render a claim to the composition patentable.” *In re Zierden*, 411 F.2d 1325, 1328, 162 USPQ 102, 104 (CCPA 1969).

In the Reply Brief, Appellant argues that Hu does not teach compositions containing the components of the claim and bases this argument on a comparison of what Hu requires to achieve the stated result of the reference to what Appellant requires to achieve her stated result (Table 1) (Reply Brief, pp. 2-3). But Appellant’s Table 1 does not make a proper comparison because it neglects the fact that Hu’s ethoxylated glucose derivative meets the requirements of component (a), Hu’s poloxamine meets the requirements of component (b), Hu’s polysorbate 20 meets the requirements of component (c) and Hu’s cellulosic polymers meet the requirements of component (d). Hu suggests a composition containing all of the claimed components.

With regard to Heiler, Appellant argues that the inventive compositions have been proven effective in removing lens deposits without polyquaternium polymers to block protein deposits (Brief, pp. 9-10). But, as pointed out by the Examiner, the presence of polyquaternium polymers is not excluded by the claims (Answer, p. 4). Nor can we agree with Appellant that the description in Heiler of including polyquaternium polymers as active ingredients to prevent the

formation of protein deposits on contact lenses means that Heiler teaches away from the compositions of the present invention (Brief, pp. 9-10). The Examiner has found that the claimed composition is suggested by Heiler and Appellant has not pointed to any evidence to the contrary.

In the Reply Brief, Appellant sets forth a chart in Table 2 purporting to compare the composition of Heiler to that of claim 1. This chart, however, does not address the findings of the Examiner. Heiler, as found by the Examiner, describes a composition containing not only polyquaternium polymers, but various surfactants and viscosity builders that meet the requirements of the claims (Answer, p. 4). Appellant has not convinced us of any reversible error on the part of the Examiner.

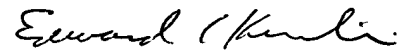
As a final point, we note that Appellant bases no arguments upon objective evidence of non-obviousness such as unexpected results. We conclude that the Examiner has established a *prima facie* case of obviousness with respect to the subject matter of claims 1-12 which has not been sufficiently rebutted by Appellant.

CONCLUSION

To summarize, the decision of the Examiner to reject claims 1-12 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED



EDWARD C. KIMLIN
Administrative Patent Judge



CHUNG K. PAK
Administrative Patent Judge



CATHERINE TIMM
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)

Appeal No. 2005-0112
Application No. 09/737,004

Page 8

John E. Thomas
Law Department
Bausch & Lomb Incorporated
One Bausch & Lomb Place
Rochester, NY 14604

CT/tdl